

REMARKS

The Official Action mailed December 21, 2005, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

Independent claims 7-9 are pending in the present application. Claims 7-9 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 7-9 as obvious based on the combination of U.S. Patent No. 6,594,740 to Fukuda and pages 2-4 of the present specification, which the Official Action refers to as "Applicant Admitted Prior Art (AAPA – Background Information)." The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365,

1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 7-9 have been amended to recite "means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright" and "means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of claiming the copyright is judged to be included and to extract title information from the acquired disk information of the target reproduction and store the extracted title information in the title area in the memory when the information of claiming the copyright is judged not to be included." Also, claims 7 and 9 have been amended to recite "means contained in the control apparatus for transferring the extracted title information from the memory." Further, claim 8 has been amended to recite "means contained in the control apparatus, in accordance with information in the title area in the memory, for editing the extracted title information to instruct the recording/reproducing apparatus to record the music data after completing the editing, and to transfer the edited title information from the memory." These features are supported in the present specification, for example, by the descriptions at page 25, lines 13-24, and steps S35, S36 and S37 in the flow chart shown in Figure 5. Fukuda and AAPA, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

Since Fukuda and AAPA do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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